



Paper No. 17

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MAR 12 2003

OFFICE OF PETITIONS

In re Application of
He, et al.
Application No. 09/930,782
Filed: 16 August, 2001
Attorney Docket No. BMS-0826/EM-6864F

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: DECISION GRANTING PETITION
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This is a decision on the petitions filed on 24 February, 2003 (supplemented via FAX on 10 March, 2003):

- under 37 C.F.R. §1.53, to correct the filing date to 16 August, 2001;
- under 37 C.F.R. §1.59 to expunge an document submitted “in error,” which “can only serve as a point of confusion.”

NOTE: The Associate Power of Attorney filed by Petitioner hereby is acknowledged and accepted. However, it is noted that while Petitioner is authorized to act on behalf of the Applicants, the Applicants also instruct the Office to maintain their former mailing address.

The petition:

- under 37 C.F.R. §1.53 is **DISMISSED**; and
- under 37 C.F.R. §1.59 is **DISMISSED as moot**.

Under the provisions of 37 C.F.R. §1.53, Petitioner seeks to:

- correct the a filing date for the instant application to 16 August, 2001;
- obtain a filing date of 16 August, 2001, for page 107 of the specification.

Under the provisions of 37 C.F.R. §1.59, Petitioner seeks to expunge a declaration made by former Counsel as to election of a filing date under 37 C.F.R. §1.182 and §1.53.

A review of the file of the instant application and of Office records thereof indicate that the filing date of record is 16 August, 2001.

Further, this application was deposited on 16 August, 2001.¹ However, on 17 September, 2001, the Office mailed a "Notice of Omitted Items in a Nonprovisional Application (Filed Under 37 C.F.R. §1.53(b))" in this Nonprovisional application, stating that the application had been accorded a filing date, and advising applicants that the application was deposited without page 107 of the specification (description and claims).

Former Counsel responded on 3 January with a petition fee, a declaration and a copy of the page in question (specification and claims), however, the matter seems otherwise to have remain unaddressed until this time. We will return to this matter below.

On 24 February, 2003, Petitioner filed the instant petition with a copy of the page Petitioner identifies a page 107 (specification and claims) and seeks to obtain a 16 August, 2001, for the document stating that:

- "the *** Utility Patent Application Transmittal (PTO/SB/05 (03-01)) for the instant application states that the application is a divisional of U.S.. Application Serial No. 09/014,734, and that 'The entire disclosure of the prior application, for which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying or divisional application and is hereby incorporated by reference. This reference can only be relied upon when a portion has been inadvertently omitted from the submitted application parts''; and
- therefore, page 107 (specification and claims) of the application satisfies the requirements of 37 C.F.R. §1.53 and should be accorded a filing date of 16 August, 2001.

The mailing of a "Notice of Omitted Items in a Nonprovisional Application" (filing date granted)" permits the applicant either:

- (1) to establish promptly prior receipt in the PTO of the page (specification and claims) at issue (generally by way of a date-stamped postcard receipt (MPEP §503)), or
- (2) promptly submit the omitted page (specification and claims) in a nonprovisional application and accept the date of such submission as the application filing date.

¹ The Utility Patent Application Transmittal page reflects a date of 15 August, 2001, and a (partial) US Postal Service (USPS) Express Mail Label No. EL 781 890 961 (sic), however there are no supporting documents in evidence such as the customer copy of the USPS Express Mail form, USPS paper tape receipt or an Office date-stamped receipt card as described in the commentary at MPEP §503. Therefore the Office receipt date of 16 August, 2001, controls.

An applicant asserting that the missing page (specification and claims) was in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit.

An applicant desiring to submit the omitted page (specification and claims) in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted page (specification and claims) with an oath or declaration in compliance with 37 C.F.R. §1.63 and 1.64 referring to such drawing(s) and a petition under 37 C.F.R. §1.182 (with the petition fee under 37 C.F.R. §1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items in a Nonprovisional Application" (filing date granted) (See: 37 C.F.R. §1.181(f)).

In this case, the matter is somewhat confused:

- while original Counsel declared that it was his appreciation that the application had been filed without page 107 (specification and claims), then submitted the document and requested a filing date consistent with the later submission, he clearly was in error as to the facts of the original filing--in particular in light of the incorporation by reference; and
- Petitioner now neither asserts that the missing page (specification and claims) was deposited on 16 August, 2001, nor requests that the missing page (specification and claims) be accorded as a filing date the date on which the it was filed (3 January, 2002, despite it's reflected 16 November, 2001, execution date).

Rather, Petitioner (as Applicant(s)) seeks to amend the application to include the page of specification and claims. However, no petition under 37 C.F.R. §1.182 is necessary for that purpose.

Amendments to the specification may be entered by the primary examiner without petition so long as the amendment contains no new matter.²

Accordingly, the petition is inappropriate and subject to **dismissal**.

As the 24 February, 2003, petition (with it's forerunner of 3 January, 2002) was not due to an error on the part of the Office, the petition fee submitted with it will not be refunded.

It is noted that the application transmittal letter identified this application as a divisional of prior application No. 09/014,734 and specifically incorporated by reference the disclosure of the prior

² See: 37 C.F.R. 1.121(b).

application.³ Obviously, in view of the incorporation by reference of the prior application, the page 107 (specification and claims) is not new matter if it was a part of the disclosure of the prior application.

The application previously has received from the Office of Initial Patent Examination processing with a filing date of 16 August, 2001, using the application papers filed on that date.

As indicated above, Petitioner seeks to have expunged under 37 C.F.R. §1.59 the 3 January, 2002, declaration of prior Counsel.

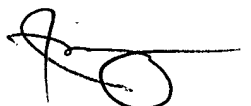
Generally, expungement questions are not ripe for determination at this stage of prosecution,⁴ and in such contexts a petition might be dismissed without prejudice subject to Petitioner's raising it at the proper time upon the filing a renewed petition (and fee).

Here the declaration contains an obvious error in that it fails to reflect the record fact that the instant application incorporated by reference the disclosure of its parent. However, the Office already has appreciated the error of former Counsel and, as indicated above, found it proper to designate the filing date as 16 August, 2001.

Therefore, the petition under 37 C.F.R. §1.59 is dismissed as moot.

The application is being forwarded to Technology Center 1600 for consideration by the Examiner of the petition filed on 24 February, 2003, as an amendment requesting the entry of the page 107 (specification and claims)⁵ with the specification and consideration of the relevancy to patentability of the declaration by former Counsel.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)305-9199.



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Office of Petitions

³ MPEP §201.06© provides that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

⁴ The "showing" requirements of MPEP §724.05 II (A-E) and "timing" requirements of MPEP §724.06, call for a determination by the Examiner as to the relevancy to patentability and a request made after allowance but before issue, respectively.

⁵ See: Fn. 1, above.